

Application No. 10/721,730
Amendment dated November 16, 2005
Reply to Office Action of August 31, 2005

REMARKS

Status Of Application

Claims 16-18 and 34-36 are pending in the application; the status of the claims is as follows:

Claims 16-18 and 34-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Komatsu et al., "A Proposal on Digital Watermark in Document Image Communication and its Application to Realizing a Signature," Electronics and Communication in Japan, Part I, Vol. 73, No. 5 (1990) ("Komatsu").

Claim Amendments

Claim 16 has been amended to more particularly point out and distinctly claim the invention. These changes are not necessitated by the prior art, are unrelated to the patentability of the invention over the prior art, and do not introduce any new matter.

Drawings

The indication, in the Office Action, that the drawings filed on November 25, 2003 are accepted, is noted with appreciation.

35 U.S.C. § 103(a) Rejection

The rejection of claims 16-18 and 34-36 under 35 U.S.C. § 103(a), as being unpatentable over Komatsu, is respectfully traversed based on the following.

The Office Action states that Applicant's arguments filed January 19, 2005 have been fully considered. However, the response to these arguments indicates that the arguments were not considered or were not understood. The office action states:

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The reference Komatsu discloses an analyzer to generate image data, a generator to generate additional data and a synthesizer to synthesize additional and image data (page 24, col. 1, lines 25-50, the image data M and the additional data S and the combination of the two as C i.e. the S and M is synthesize[d] to form a[sic] image data) as claimed.

Komatsu does describe synthesizing image data M with watermark information S to form synthesized document C (formula 5 on page 24). However, it is not and was never Applicant's position that Komatsu does not describe this.

In contrast to the cited references, claim 16 includes the following limitation:

a generator configured to generate additional data ***based on said received code data; ... [italics added]***

Thus, the additional data is generated based on the received code data from which the image data is generated. Komatsu does not indicate any particular basis for the information used to generate watermark S. It does state several characteristics of the watermark S, but never states a specific basis for generating watermark S. Because Komatsu does not state any basis or source for its watermark data, it certainly does not show or suggest that the "additional data" is generated "based on said received code data." There is no reasonable interpretation of this limitation of claim 16 that can be said to be shown or suggested in the Komatsu reference. To support a *prima facie* case for obviousness, the reference must show or suggest every limitation of the claim. MPEP §2143.03. Therefore, claim 16 is not obvious over the cited references. Claims 17 and 18 are dependent upon claim 16 and thus include every limitation of claim 16. Therefore, claims 17 and 18 are also not obvious over the cited references.

Also in contrast to the cited references, claim 34 includes:

generating additional data ***based on said received code data; ... [italics added]***

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As noted above, the cited references do not show or suggest any basis or source for generating additional data from the received code data. Thus, the cited references do not show or suggest every limitation of claim 34. Therefore, claim 34 is not obvious over the cited references. Claims 35 and 36 are dependent upon claim 34 and thus include every limitation of claim 34. Therefore, claims 35 and 36 are also not obvious over the cited references.

Accordingly, it is respectfully requested that the rejection of claims 16-18 and 34-36 under 35 U.S.C. § 103(a) as being unpatentable over Komatsu, be reconsidered and withdrawn.

CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

Any fee required by this document other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

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Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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November 16, 2005